

ATTORNEY DOCKET NO. US 010499
U.S. SERIAL NO. 09/971,143
PATENT

REMARKS

Claims 1-20 were pending in this application.

Claims 1-20 have been rejected.

Claims 1 and 13 have been amended as shown above.

Claims 1-20 remain pending in this application.

Reconsideration and full allowance of Claims 1-20 is respectfully requested.

I. REJECTION UNDER 35 U.S.C. § 103

The Office Action rejects Claims 1-20 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Publication No. US 2001/0018660A1 to Sehr ("Sehr") in view of United States Patent Publication No. US 2003/0163373A1 to Cornateanu ("Cornateanu"). This rejection is respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142, p. 2100-133 (8th ed. rev. 3 August 2005). Absent such a *prima facie* case, the applicant is under no obligation to produce evidence of nonobviousness. *Id.*

To establish a *prima facie* case of obviousness, three basic criteria must be met: First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference

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(or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *Id.*

Sehr teaches an electronic card for automated admission to events and for tracking the purchases of goods and services to generate, for example, shopper's points. (See e.g., *Sehr*, ¶¶ [0011] & [0012]). *Sehr* also teaches using the card for a plurality of other services, including, for example, admission into an event, electronic payments for goods and services, and for tracking consumption patterns. (*Id.* at ¶ [0034]).

Cornateanu teaches using a data storage device for receiving, scanning, storing and transmitting coupon data. (See e.g., *Cornateanu*, ¶¶ [0033]-[0035]). After a user scans a product's bar code, *Cornateanu* discloses that the data storage device retrieves and displays any available coupons for that product. (*Id.* at ¶¶ [0037] & [0038]).

For these reasons, *Sehr* and *Cornateanu* fail to make obvious Applicants' invention as recited in Claims 1, 13 and 18.

Claims 2-12, 19 and 20 ultimately depend from Claim 1. As described above, Claim 1 is patentable. As a result, Claims 2-12, 19 and 20 are patentable due to its dependence from an allowable base claim.

Claims 14-17 ultimately depend from Claim 13. As described above, Claim 13 is patentable. As a result, Claims 14-17 are patentable due to its dependence from an allowable base claim.

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Accordingly, the Applicants respectfully request withdrawal of the § 103 rejection and full allowance of Claims 1-20.

II. CONCLUSION

The Applicants respectfully assert that all pending claims in this application are in condition for allowance and respectfully requests full allowance of the claims.

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SUMMARY

If any outstanding issues remain, or if the Examiner has any further suggestions for expediting allowance of this application, the Applicants respectfully invite the Examiner to contact the undersigned at the telephone number indicated below or at wmunck@davismunck.com.

The Commissioner is hereby authorized to charge any additional fees connected with this communication (including any extension of time fees) or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

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Date: October 27, 2005



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